

**REMARKS****Summary of the Office Action**

In the Office Action, claims 1-11 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Pub. No. 2001/0052386 to *Treleven*.

**Summary of the Response to the Office Action**

Applicant proposes adding new claims 25-29. Based upon the remarks presented below, claims 1-11 and 25-29 are pending for further consideration, with claims 12-24 being withdrawn from consideration per the Restriction Response filed April 21, 2005.

**All Claims are Allowable**

In the Office Action, claims 1-11 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Pub. No. 2001/0052386 to *Treleven*. Applicant respectfully traverses the rejection of claims 1-11 for the following reasons.

With regard to independent claim 1, Applicant respectfully asserts that *Treleven* does not teach or fairly suggest a paperback rider instantly redeemable coupon (IRC) including, “a liner including inner and outer sections on a first face thereof; a booklet including first and second surfaces, said first surface of said booklet being disposed substantially adjacent said inner section on said first face of said liner; a first laminate being adhesively affixed to said second surface of said booklet and including inner and outer sections on first and second faces thereof, said inner section of said first face of said first laminate being affixed to said booklet, said outer section of said first face of said first laminate being affixed to said outer section of said liner to substantially enclose said booklet between said first laminate and said liner; and an IRC disposed substantially adjacent said inner section on said second face of said first laminate and having a second laminate adhesively affixed thereon, said second laminate including inner and outer sections on a first face thereof, said inner section of said second laminate being affixed to said IRC and said outer section of said second laminate being affixed to said outer section of said second face of said first laminate,” as recited in independent claim 1.

Support for these features recited in claim 1 can be found at least in Paragraphs 0010-0013, and 0027-0036 of the originally filed specification, and in Figs. 2-5 of the originally

filed drawings. Specifically, as shown in Figs. 2 and 3, the present invention provides a paperback rider instantly redeemable coupon (IRC) including a liner (i.e. film) 26 having inner and outer sections on a first face thereof, and a booklet 12 including first and second surfaces. The first (i.e. inner) surface of the booklet may be disposed substantially adjacent the inner section on the first face of the liner. A first laminate (i.e. clear film) 32 may be adhesively affixed to the second (i.e. outer) surface of the booklet and include inner and outer sections on first and second faces thereof. As shown, the inner section (i.e. inner area of inner face) of the first face of the first laminate may be affixed to the booklet and the outer section (i.e. outer ends of inner face) of the first face of the first laminate may be affixed to the outer section of liner 26 to substantially enclose the booklet between the first laminate and the liner. An IRC 14 may be disposed substantially adjacent the inner section on the second (i.e. outer) face of the first laminate (i.e. clear film 32) and have a second laminate (i.e. clear film 28) adhesively affixed thereon. The second laminate may include inner and outer sections on a first face thereof. The inner section (i.e. area adjacent or between perforations 38) of the second laminate may be affixed to the IRC and the outer section (i.e. area beyond perforations 38) of the second laminate may be affixed to the outer section of the second face of the first laminate.

The Office Action cites *Treleaven* as teaching or suggesting the paperback rider instantly redeemable coupon (IRC) recited in claims 1-11.

Specifically, *Treleaven*, as illustrated in Figs. 1 and 2 thereof, discloses a multi-ply resealable label 100. As discussed in Paragraph 0034 of *Treleaven*, in order to use label 100, the label may be applied to a suitable substrate such as a container by means of a base adhesive 104. When a user wishes to access the information on the inside of label 100, the user may grasp the corner or pull tab 103 of the combined top panel 130 and laminate cover 150 adjacent the tab 137. The user may then pull the corner 103 toward the hinge 106 (as illustrated from right to left), thereby causing the laminate adhesive portion 154A to peel away from the varnish coated tab 137. The underside of the top panel 130 preferably includes printed indicia 118 such as a bar code. The top panel 130 may be repeatedly opened and closed by rejoining the adhesive portion 154A with the tab 137. The area of adhesive 154A exposed upon opening the label 100 may be limited to that needed to ensure reliable closure of the label.

Thus as clearly described in Paragraph 0034 of *Treleaven*, label 100 is designed to be repeatedly opened and closed for accessing information 118 on the bottom of top panel 130, with varnish coated tab 137 functioning as a resealing means.

In a further embodiment of resealable label 100, as illustrated in Figs. 6 and 7 and discussed in Paragraphs 0042-0044 of *Treleaven*, it is indicated that label 100 may be instead formed using folded leaflets 140B, which are formed from a sheet 131B including J-shaped cuts 136B formed therein. A continuous strip or dots of adhesive 134B corresponding to the adhesive strips 134 (see Fig. 1) are applied along the sheet 131B. Adhesive patches 138B are applied to sheet 131B in locations corresponding to the adhesive patches 138. Varnish patches 139B (similar to varnish patch 139 of Figs. 1 and 2) are printed on the opposite side of sheet 131B adjacent the cut lines 136B and in locations corresponding to varnish 139 (see again Fig. 1). The sheet 131B is folded along a fold 135B to divide the sheet 131B into a top panel 130B corresponding to the top panels 130 (see Fig. 1) and a bottom panel 110B corresponding to the base labels 110 (see Fig. 1). The adhesive 134B adheres panels 130B and 110B adjacent the fold line 135B.

Thus as clearly described in Paragraphs 0042-0044 of *Treleaven*, the labels illustrated in the Figs. 6 and 7 embodiment are virtually identical to the label of Fig. 1, except that the Figs. 6 and 7 labels are formed of a folded sheet 131B, whereas the labels of Fig. 1 are formed of bonded layers as shown in Fig. 1.

In distinct contrast to the teachings of *Treleaven*, for the present invention, the paperback rider instantly redeemable coupon (IRC) 10 as illustrated in Figs. 2 and 3, clearly includes five distinct layers, as also clearly recited in independent claim 1.

Specifically, as shown in Fig. 2, the present invention paperback rider instantly redeemable coupon (IRC) 10 includes (1) a first liner layer 26, (2) a booklet layer 12, (3) a first laminate (i.e. clear film) layer 32, (4) an IRC 14, and (5) a second laminate (i.e. clear film) layer 28. As discussed in paragraph 0029 of the specification, in order to use paperback rider instantly redeemable coupon (IRC) 10, a cashier may remove IRC 14 by grasping one corner and tearing along the two vertical perforations 38. The booklet 12, encased within film 26 and clear film 32, would be left intact still firmly secured to the package or product for later removal by the consumer.

On the contrary, *Treleaven* clearly does not teach or suggest the five distinct layers which form the present invention paperback rider instantly redeemable coupon (IRC) 10. Instead, *Treleaven* merely discloses a label 100 designed to be repeatedly opened and closed for accessing the information 118 on the bottom of top panel 130, with varnish coated tab 137 functioning as a resealing means. *Treleaven* further discloses various embodiments of label 100, of which the Fig. 1 embodiment includes a variety of stacked layers and the Fig. 6 embodiment includes a label formed of folded layers.

Based upon the express disclosure of *Treleaven*, label 100 has absolutely nothing in common with the present invention paperback rider instantly redeemable coupon (IRC) 10, as recited in independent claim 1.

Specifically, referring to independent claim 1 of the present invention, *Treleaven* clearly does not teach or suggest, a paperback rider instantly redeemable coupon (IRC) including:

“a booklet including first and second surfaces, said first surface of said booklet being disposed substantially adjacent said inner section on said first face of said liner,” or

“a first laminate being adhesively affixed to said second surface of said booklet and including inner and outer sections on first and second faces thereof, said inner section of said first face of said first laminate being affixed to said booklet, said outer section of said first face of said first laminate being affixed to said outer section of said liner to substantially enclose said booklet between said first laminate and said liner,” or

“an IRC disposed substantially adjacent said inner section on said second face of said first laminate and having a second laminate adhesively affixed thereon, said second laminate including inner and outer sections on a first face thereof, said inner section of said second laminate being affixed to said IRC and said outer section of said second laminate being affixed to said outer section of said second face of said first laminate,” as recited in independent claim 1.

As pointed out in MPEP § 2131, “[t]o anticipate a claim, the reference must teach every element of the claim.” “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

*Verdegaal Bros. v. Union Oil Co. Of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

Moreover, as pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re*

*Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). Since these criteria have not been met, Applicant respectfully asserts that the rejections under 35 U.S.C. § 102 (e) should be withdrawn because *Treleaven* does not teach or suggest each feature of independent claim 1.

In view of the above arguments, Applicant respectfully requests the rejection of independent claim 1 under 35 U.S.C. § 102 be withdrawn. Additionally, claims 2-5, which depend from independent claim 1, are allowable at least because their base claim is allowable, as well as for the additional features recited therein.

#### Independent claim 6

With regard to independent claim 6, Applicant respectfully asserts that *Treleaven* does not teach or fairly suggest a paperback rider instantly redeemable coupon (IRC) including, “a liner including inner and outer sections on a first face thereof; a booklet including first and second surfaces, said first surface of said booklet being disposed substantially adjacent said inner section on said first face of said liner; a laminate being adhesively affixed to said second surface of said booklet and including inner and outer sections on a first face thereof, said inner section of said first face of said laminate being affixed to said booklet, said outer section of said first face of said laminate being affixed to said outer section of said liner to substantially enclose said booklet between said laminate and said liner; and an IRC disposed on a second face of said laminate and releasably affixed thereto by a dry release adhesive for permitting separation of said IRC from said paperback rider IRC,” as recited in independent claim 6.

Applicant respectfully asserts that independent claim 6 is allowable for at least the reasons presented above for the allowance of independent claim 1, and the additional features recited therein. In the interest of avoiding redundant arguments, the reasons for the allowance of independent claim 6 are not repeated herein. Additionally, claims 7-11 which depend from independent claim 6, are allowable at least because their base claim is allowable, as well as for the additional features recited therein.

#### New Independent claim 25

With regard to new independent claim 25, Applicant respectfully asserts that *Treleaven* does not teach or fairly suggest a paperback rider instantly redeemable coupon (IRC) including,

“a liner including inner and outer sections on a first face thereof; a booklet including first and second surfaces, said first surface of said booklet being disposed substantially adjacent said inner section on said first face of said liner; a first laminate being adhesively affixed to said second surface of said booklet and including inner and outer sections on first and second faces thereof, said inner section of said first face of said first laminate being affixed to said booklet, said outer section of said first face of said first laminate being affixed to an area of said outer section of said liner to substantially enclose said booklet between said first laminate and said liner; and an IRC disposed substantially adjacent said inner section on said second face of said first laminate and having a second laminate adhesively affixed thereon, said second laminate including inner and outer sections on a first face thereof, said inner section of said second laminate being affixed to said IRC and said outer section of said second laminate being affixed to an outermost area of said outer section of said liner,” as recited in independent claim 25.

Applicant respectfully asserts that new independent claim 25 is allowable for at least the reasons presented above for the allowance of independent claim 1, and the additional features recited therein. Additionally, claims 26-29 which depend from independent claim 25, are allowable at least because their base claim is allowable, as well as for the additional features recited therein.


### **CONCLUSION**

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 04-2223. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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